



10-24407

1621

IPR

October 22, 2007

Assistant Commissioner for U.S. Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Regarding- infringement of U.S. Patent 6,623,768 of Yousry NAGUIB; and U.S. Patent Application 10/551,772 of Ezio BOMBARDELLI et al. (Examiner Sudhakar KATAKAM, and Supervisory Patent Examiner Dr. Eyler YVONNE).

Sir:

As I mentioned in my letters (copy is enclosed) dated April 19, 2007 and May 18, 2007 to Mr. Sudhakar Katakam that the U.S. Patent Application No. 10/551,772 of Ezio Bombardelli et al., entitled 'Process for the preparation of ferutinine from ferula genus plants,' contains claims 1,3 ,4 ,5 and 6 which infringe claims 1,5 ,6 ,7 ,8 and 10 of my U.S. Patent No. 6,623,768.

Claims 1, 2, and 6 of U.S. Patent 6,623,768 disclose a pharmaceutically active composition consists of terpenoid compounds extracted by supercritical carbon dioxide PROCESS.

Claim 1(a) of U.S. Patent Application No. 10/551,772 discloses extraction of daucane esters (which are terpenoid compounds) from Ferula spp extracted from Ferula hermonis (claim 3) by supercritical carbon dioxide (claim 4). This PROCESS is identical to that disclosed in my U.S. Patent 6,623,768; namely extracting terpenoids (daucane esters) from Ferula hermonis by supercritical carbon dioxide.

Ferutinin, Teferdin, Ferutinol, and their structurally similar chemical compounds are derivatives of Jaeschkeanadiol. Jaeschkeanadiol is a daucane alcohol. Daucane is a class of sesquiterpenes formed by assembly of three isoprenoid units (Dictionary of Natural Products by Buckingham, J.E.; CRC Press, 1994).

The use of terpenoids from Ferula hermonis in an ointment is also disclosed in my U.S. Patent 6,623,768.

**On the basis of this and explanation given in my letters dated April 19, 2007 and May 18, 2007 rejection of Claim 3 and amendment of part a of claim 1 to specify *Ferula communis* and not *Ferula spp* (which includes *hermonis*) in Application 10/551,772 of Ezio BOMBARDELLI et al. is respectively requested.**

Please respond to this letter and my letters dated April 19, 2007 and May 18, 2007.

Respectfully submitted

*Yousry Naguib*

**Yousry Naguib, Ph.D. (Organic Chemistry)  
19 E. Newman Avenue  
Arcadia, CA 91006**

**Ph. (626) 445-7939**

**Cell (626)228-8691**

**Cc: Commissioner of U.S. Patents**

**Dr. Eyler Yvonne**

**Sudhakar Katakam**



April 19, 2007

Mr. Sudhakar Katakam  
Group Art Unit: 1621  
United States Patent and Trademark Office  
P.O.Box 1450  
Alexandria, VA 22313-1450

Regarding- Infringement of U.S. Pat. No. 6,623,768 by Yousry M.A. Naguib

Dear Mr. Katakam:

I am the inventor of the U.S. Pat. No. 6,623,768, entitled "Pharmaceutically active composition extracted from Ferula hermonis and process of its extraction"; I would like to inform you that the U.S. Patent Application No. 10/551,772 (inventors: Ezio Bombardelli, Gabriele Fontana, Aldo Cristoni, Enrico Mercalli), entitled "Process for the preparation of ferutinine from ferula genus plants," of which you are the examiner, contains claims which infringe the claims of my U.S. Pat. No. 6,623,768. Please let me know if you need any information pertaining to this matter. I shall look forward to an acknowledgement of receiving this letter.

Sincerely Yours,

*Yousry Naguib*

Yousry M.A. Naguib  
626-445-7939  
19 E. Newman Avenue  
Arcadia, CA 91006

CC/ Commissioner of United States Patent and Trademark Office



12

May 18, 2007

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Regarding- infringement of U.S. Patent 6,623,768 of Yousry NAGUIB; and U.S. Patent Application 10/551,772 of Ezio BOMBARDELLI et al. (Examiner Sudhakar KATAKAM).

Sir:

As I mentioned in my letter dated April 19, 2007 to Mr. Sudhakar Katakam that the U.S. Patent Application No. 10/551,772 of Ezio Bombardelli et al., entitled "Process for the preparation of ferutinine from ferula genus plants," contains claims 1,3 ,4 ,5 and 6 which infringe claims 1,5 ,6 ,7 ,8 and 10 of my U.S. Patent No. 6,623,768.

Ferula genus consists of about 170 species of flowering plants (see <http://en.wikipedia.org/wiki/Ferula>) including assafoetida, communis, and hermonis. Not all the ferula species contain daucane compounds.

Daucane compounds in claim 1 of Application 10/551,772 are terpenoid compounds (sesquiterpenes) as given this nomenclature in claim 2 of U.S. Patent 6,623,768.

U.S. Patent 6,623,768 discloses a pharmaceutically active composition extracted from ferula hermonis by supercritical carbon dioxide (claim 5) at temperatures ranging from 31 to 80 degree C. and pressures between 150 and 400 bar (claim 7). The pharmaceutically active composition comprising terpenoid compounds (see Figure 1 in U.S. Pat.-No. 6,623,768), of which compounds can be hydrolyzed to Jaeschkenadiol and then esterified to ferutinine.

In U.S. Patent Application 10/551,772 part a of claim 1 and claim 3 infringe part b of claim 1 (extraction) of U.S. Patent 6,623,768.

In U.S. Patent Application 10/551,772 claim 4 infringes claims 5 and 7 of U.S. Patent 6,623,768.

**Please reject claim 3 and amend part a of claim 1 to specify *Ferula communis* and not *Ferula spp* (which includes *hermonis*) in Application 10/551,772 of Ezio BOMBARDELLI et al.**

Please let me know if you need further information.

Respectfully submitted



Yousry Naguib, Ph.D. (Organic Chemistry)

19 E. Newman Avenue

Arcadia, CA 91006

Ph. (626) 445-7939

Cell (626)228-8691